

Notice of Allowability

Application No.

10/512,135

Examiner

Marc S. Zimmer

Applicant(s)

TSUMURA ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 06/21/07.
2. ☒ The allowed claim(s) is/are 1,3,4,7-27,29-33,36-46 and 49-63.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

In line 1 of claims 22-23, 31-32, and 39-40, please replace the word "curing" with

-- cured --.

In claim 24, line 2, please replace the word "curing" with

-- cured --.

Allowable Subject Matter

Claims 1, 3-4, 7-27, 29-33, 36-46, and 49-63 are pending. In response to the Examiner's indication that claims 7 and 49 contained allowable subject matter, independent claims 1, 25, 41, and 43 have been amended to include the requirement that a borate ester condensation catalyst be present in the claimed compositions/sealing members. An updated survey of the prior art did not yield a reference more germane than those already of record hence these claims, and the claims dependent therefrom are allowable.

Independent claim 33, on the other hand, does not contemplate the insertion of a borate ester compound. Rather, Applicant has amended this claim such that component (B) is limited to one of two compounds derived from the reaction of

tetramethylcyclotetrasiloxane and an allylated isocyanurate compound. Applicants contend that *Ouchi* does not teach an equivalent compound, an assertion with which the Examiner does not agree. Applicants further attempt to overcome the rejection of this invention by providing empirical data that allegedly illustrates unexpected, superior results associated with the employment of a compound (B) derived from an isocyanurate bearing both glycidyl substituents and allyl substituents and tetramethylcyclotetrasiloxane when compared with another crosslinker derived from triallyl isocyanurate and tetramethylcyclotetrasiloxane. The Examiner does not see any probative value in the declaration provided insofar as it is believed that a rejection under 35 U.S.C 102 is appropriate. Indeed, *Ouchi* teaches a composition comprising components (A) and (C) and also contemplates the addition of a crosslinker for which there are many permutations disclosed including that which is derived from tetramethylcyclotetrasiloxane and an isocyanurate compound bearing glycidyl- and allyl substituents.

A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that "the tenth edition of the Merck Index lists ten thousand

compounds. In our view, each and every one of those compounds is described' as that term is used in 35 U.S.C. § 102(a), in that publication."). Id. at 1718.

Claims 33 and 36-40 are, nevertheless, allowable because at least one of the priority documents for which Applicant has perfected their priority claim fully supports the subject matter of these claims. That is to say, Applicant may rely on their foreign priority claim to overcome a rejection over *Ouchi*.

An updated survey of the prior art did not yield a reference more germane than those already cited hence claims 1, 3-4, 7-27, 29-33, 36-46, and 49-62 are now deemed allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

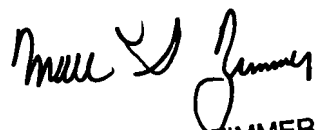
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 18, 2007


MARC S. ZIMMER
PRIMARY EXAMINER